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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|---------------------------|---------------------|------------------|
| 10/749,906 | 12/29/2003 | Suman Preet Singh Khanuja | 11378.56US01 | 1377 |
| 23552 | 7590 | 08/24/2004 | | |
| MERCHANT & GOULD PC | | | | EXAMINER |
| P.O. BOX 2903 | | | | HWU, JUNE |
| MINNEAPOLIS, MN 55402-0903 | | | | ART UNIT |
| | | | | PAPER NUMBER |
| | | | | 1661 |

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/749,906 | KHANUJA ET AL. |
| | Examiner | Art Unit |
| | June Hwu | 1661 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 December 2003.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 29 December 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The declaration filed May 10, 2004 has been acknowledged.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

In the declaration, Applicants must state that they have asexually reproduced the plant and if the plant is a newly found plant the oath/declaration must state that it was found in a cultivated area. A new declaration is required. See 37 cfr1.162. No new fees are required.

Drawing

The disclosure is objected to under 37 CFR 1.165(b) because applicant has not provided copies of the drawing in duplicate. Correction is required.

The disclosure is objected to under 37 CFR 1.165(a) because Fig. 3 is not artistically and/or competently executed. The drawing is a black and white photocopy of the foliage and does not disclose all the distinctive characteristics of the plant capable of visual representation. A colored replacement drawing of the instant cultivar plant habit, stem including the foliage, and inflorescence in duplicate must be submitted.

The disclosure should not contain descriptive information with regard to the figures and such should be imported into the specification under the brief description of the drawings. See 37 CFR 1.84(o).

The disclosure is objected to under 37CFR1.84(u) because the view numbers must be preceded by the abbreviation "FIG." Replacement drawings are required.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

More specifically:

A. The Latin name of the genus, species and variety denomination of the claimed plant should be stated and preceded by the heading set forth in 37 CFR 1.163(c)(4), (c)(5) and (d).

See MPEP 1605.

B. The specification does not "particularly point out where and in what manner the variety of plant has been asexually reproduced". Correction is required.

C. Applicant should clearly set forth in the specification the phenotypic characteristic that distinguishes the claimed plant from its parents and related known varieties.

D. Page 3, line 18, the recitation "Q per ha" is unclear to the herbage yield. Clarification is necessary.

E. Applicants should set forth in the specification the surface texture of the stem.

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F. Page 3, line 26 and page 10, line 11, Applicants describe the leaf coloration as "RHS 137A" but it is unclear if this color designation is of the upper or lower leaf. Clarification and correction are necessary and should include both upper and lower surface colors.

G. Page 4, line 18 and page 11, line 6, the recitation "purple" is vague and does not clearly describe the color designation of the corolla with reference to the employed color chart.

H. Page 4, line 19, the recitation "white flowers" is vague and does not clearly describe the color designation with reference to the employed color chart of the flowers. Correction is necessary.

I. Clarification is necessary with regard to the color designation of the corolla/flower because Applicants describe the corolla as "purple" and then the flowers as "white" on page 4, lines 18-19. It is unclear as to what part of the flower is purple and/or white or if the flower starts out purple when young then matures to white.

J. Applicants should set forth in the specification the average size of the inflorescence, flower, calyx, anthers, filaments, stigma, and style.

K. Applicants should set forth in the specification a botanical description of the peduncle's diameter, surface texture, average length and color designation with reference to an employed color chart.

L. Applicants should import into the specification the foliage and/or flower fragrance.

M. Applicants should set forth in the specification the color designation with reference to the employed color chart of the filaments, stigma and style.

N. Applicants should set forth in the specification number of pistils.

O. Applicants should set forth in the specification whether fruit/seeds are produced. If so, Applicant should disclose such information and describe these structures in the interest of providing as complete a botanical description of the observed plant as is reasonably possible or if not produced state -- none --.

P. Page 7, lines 13 and 17 and Table 3, the recitation "□" is unclear. Clarification is necessary.

Q. Applicants should provide a photograph that shows the polymorphism between the claimed cultivar and its parent using RAPD analysis.

R. Page 12, lines 5-6, Applicants describe the cluster analysis of the claimed cultivar with other varieties. Applicants should set forth in the specification the program used for the analysis such as NTSYS.

S. Applicants should set forth in the specification the description of all the lanes, specific markers used in Lanes 1-21. A reminder that Applicants must comply with the requirements for patent application containing nucleotide sequence and/or amino acid sequence disclosure of 37 CFR 1.821 through 1.825.

T. The claim shall be in formal terms to the instant variety as described and illustrated. An example of a proper claim would be "A new and distinct variety of mint plant, substantially as illustrated and described herein ...". See MPEP 1605 and 37 CFR1.164. Correction is required.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Claim Rejection

35 USC § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH



ANNE MARIE GRUNBERG
PRIMARY EXAMINER